IFW 1632

Attorney Docket No. PC10347A

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By Kelley D. Surprenant
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: **Graham N. Maw, et al.**

APPLICATION NO.: **09/939,093** EXAMINER: **J. Hama**

FILED: **08/24/2001** ART UNIT: **1632**

FOR: **PHARMACEUTICAL**

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

RESPONSE UNDER 37 CFR §1.111

Applicants hereby respond to the Office Action mailed December 21, 2004 in the subject patent application.

In response to the restriction requirement, Applicants provisionally elect the claims of Group II (i.e., claims 7-13) with traverse.

Applicants request that the restriction requirement be reconsidered on the grounds that the Examiner has not shown that a serious burden would exist in examining all the claims together.

MPEP § 803 provides, "*[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.*" Thus, for a restriction requirement to be proper, the Examiner must satisfy the following two criteria: (1) the existence of independent and distinct inventions (35 U.S.C. §121); *and* (2) that the search and examination of the entire application cannot be made without serious burden. See MPEP §803.

The Examiner has not shown that the second requirement has been met. Specifically, the Examiner has not shown that it would be a serious burden to search and examine the claims of the Application together, particularly with respect to the claims of

Groups I and II. The claims of Group II (claims 7-13) are directed to methods of treatment comprising, *inter alia*, administering to a subject an agent capable of modulating an IK_{Ca} channel activity. The claims of Group I (claims 1-6) are directed to pharmaceutical compositions comprising, *inter alia*, an agent capable of modulating the activity of an IK_{Ca} channel. Applicants respectfully note the Examiner's statement that Group I and II are related as product and process of use.

It would constitute an undue burden on Applicants to limit the examination to the elected group of claims. If followed, the present restriction requirement would require Applicants to file numerous applications directed to individual aspects of Applicants' invention. The cost of prosecuting and maintaining these applications, and any patents which may issue therein, would be unreasonable.

Consequently, reconsideration and modification or withdrawal of the restriction and requirements are respectfully requested for all claims, but particularly with respect to the claims of Groups I and II.

Respectfully submitted,

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